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PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: J. Doherty et al.

Serial No.: 10/530,840 **Case No.:** 21260YP

Filed: April 8, 2005

For: Ophthalmic Compositions for Treating Ocular Hypertension

Art Unit
1626

Auth. Off.:
R. Anderson

Mail Stop Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

RESPONSE TO RESTRICTION REQUIREMENT

Sir:

This paper is filed in response to the restriction requirement mailed January 8, 2008 and for which a response is due on February 8, 2008. Claims 1-12 are currently pending in the application and are subject to the following restriction under 35 U.S.C. 121:

Group I: Claims 1-4 and 9-12 drawn to products of the fomula I wherein R2 is (CH₂)_nC₆₋₁₀ aryl; R3 is (CH₂)_nC₃₋₁₀ heterocycle; X is (CHR₇)pCO; Y is CO(CH₂)_n and Q is N.

Group II: Claims 1-4 and 9-12 drawn to products of the fomula I wherein R2 is (CH₂)_nC₆₋₁₀ aryl; R3 is (CH₂)_nC₃₋₁₀ heterocycle; X is (CHR₇)pCO; Y is CO(CH₂)_n and Q is O.

Group III: Claims 1-4 and 9-12 drawn to products of the fomula I wherein R2 is (CH₂)_nC₆₋₁₀ aryl; R3 is (CH₂)_nC₃₋₁₀ heterocycle; X is (CHR₇)pCO; Y is CH₂ and Q is N.

Group IV: Claims 1-4 and 9-12 drawn to products of the fomula I wherein R2 is (CH₂)_nC₆₋₁₀ aryl; R3 is (CH₂)_nC₃₋₁₀ heterocycle; X is (CHR₇)pCO; Y is CH(OR) and Q is N.

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Group V: Claims 1-4 and 9-12 drawn to products of the fomula I wherein R2 is (CH2)_nC6-10 aryl; R3 is (CH2)_nC3-10 heterocycle; X is (CHR7)_pCO; Y is CH2 and Q is O.

Group VI: Claims 1-4 and 9-12 drawn to products of the fomula I wherein R2 is (CH2)_nC6-10 aryl; R3 is (CH2)_nC3-10 heterocycle; X is (CHR7)_pCO; Y is CH(OR) and Q is O.

Group VII: Claims 1-4 and 9-12 drawn to products of the fomula I wherein R2 is (CH2)_nC6-10 aryl; R3 is (CH2)_nC3-10 heterocycle; X is (CHR7)_p; Y is CO(CH2)_n and Q is N.

Group VIII: Claims 1-4 and 9-12 drawn to products of the fomula I wherein R2 is (CH2)_nC6-10 aryl; R3 is (CH2)_nC3-10 heterocycle; X is (CHR7)_p; Y is CO(CH2)_n and Q is O.

Group IX: Claims 1-4 and 9-12 drawn to products of the fomula I wherein R2 is (CH2)_nC6-10 aryl; R3 is C1-10 alkyl; X is (CHR7)_pCO; Y is CO(CH2)_n and Q is N.

Group X: Claims 1-4 and 9-12 drawn to products of the fomula I wherein R2 is (CH2)_nC6-10 aryl; R3 is C1-10 alkyl; X is (CHR7)_pCO; Y is CO(CH2)_n and Q is O.

Group XI: Claims 1-4 and 9-12 drawn to products of the fomula I wherein R2 is C1-10 alkyl; R3 is (CH2)_nC3-10 heterocycle; X is (CHR7)_pCO; Y is CO(CH2)_n and Q is N.

Group XII: Claims 1-4 and 9-12 drawn to products of the fomula I wherein R2 is C1-10 alkyl; R3 is (CH2)_nC3-10 heterocycle; X is (CHR7)_pCO; Y is CO(CH2)_n and Q is O.

Group XIII: Claims 1-4 and 9-12 drawn to methods of use for products of the fomula I wherein R2 is (CH2)_nC6-10 aryl; R3 is (CH2)_nC3-10 heterocycle; X is (CHR7)_pCO; Y is CO(CH2)_n and Q is N.

Group XIV: Claims 1-4 and 9-12 drawn to methods of use for products of the fomula I wherein R2 is (CH2)_nC6-10 aryl; R3 is (CH2)_nC3-10 heterocycle; X is (CHR7)_pCO; Y is CO(CH2)_n and Q is O.

Group XV: Claims 1-4 and 9-12 drawn to methods of use for products of the fomula I wherein R2 is (CH2)_nC6-10 aryl; R3 is (CH2)_nC3-10 heterocycle; X is (CHR7)_pCO; Y is CH2 and Q is N.

Group XVI: Claims 1-4 and 9-12 drawn to methods of use for products of the fomula I wherein R2 is (CH2)_nC6-10 aryl; R3 is (CH2)_nC3-10 heterocycle; X is (CHR7)_pCO; Y is CH(OR) and Q is N.

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Group XVII: Claims 1-4 and 9-12 drawn to methods of use for products of the formula I wherein R₂ is (CH₂)_nC₆₋₁₀ aryl; R₃ is (CH₂)_nC₃₋₁₀ heterocycle; X is (CHR₇)_pCO; Y is CH₂ and Q is O.

Group XVIII: Claims 1-4 and 9-12 drawn to methods of use for products of the formula I wherein R₂ is (CH₂)_nC₆₋₁₀ aryl; R₃ is (CH₂)_nC₃₋₁₀ heterocycle; X is (CHR₇)_p; Y is CO(CH₂)_n and Q is O.

Applicants respectfully traverse the restriction requirement. The Examiner asserts that the restriction is proper because the inventions listed in Groups I to XVIII do not relate to a single general inventive concept under PCT Rule 13.1 in that they lack the same or corresponding technical features. Applicants respectfully submit that the Examiner fails to justify the restriction requirement as the present invention of Groups I-XVIII are related. Even though only one invention may be claimed in a single application, a reasonable number of species of the invention can be claimed if there is an allowable generic claim in the application, which is the case of the present application. Accordingly, there is no additional burden on the part of the Examiner to conduct the prior art search for examination of the present application in total. Moreover, Applicants are unable to elect any of the groups designated by the Examiner as they do not allow for the selected species of Example 27. Applicants would like to suggest an alternate group, that being Group XVIII directed to Claims 1-4 and 9-12 drawn to products of the formula I wherein R₂ and R₃ are independently H, C₁₋₁₀ alkyl or (CH₂)_nC₃₋₈ cycloalkyl; X is (CHR₇)_pCO; Y is CO(CH₂)_n and Q is N. This suggested group contains all the unity of invention requirements and puts no additional burden on the part of the Examiner to conduct the prior art search.

As required by the Examiner, applicants assert that claims 1 through 12 are identified as encompassing the elected invention.

In view of the above, the Examiner is respectfully requested to withdraw the restriction requirement.

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Authorization is hereby given to charge any fees which may be due as a result of this petition to Deposit Account No. 13-2755.

Respectfully submitted,

By: 

Sylvia A. Ayler

Reg. No. 36,436

Attorney for Applicant(s)

MERCK & CO., INC.

P.O. Box 2000

Rahway, New Jersey 07065-0907

(732) 594-4909

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